

REMARKS/ARGUMENTS

Claims 1-2, 4-15, 17-18, and 21-23 have been canceled. Claim 16 has been amended to include the limitation of (previously) dependent Claim 17. Thus, no new matter has been added by this amendment. Claims 16, 19, and 20 remain in the application. Reconsideration of this application is respectfully requested.

1. REAL PARTY IN INTEREST

The real party in interest for the purpose of these remarks is Motorola, Inc.

2. STATUS OF CLAIMS

These remarks are in response to a final Office Action dated June 24, 2004. Claims 16, 19, and 20 are being prosecuted in the application. In the final Office Action dated June 24, 2004, the Examiner rejected Claims 1-2, 4-10, 14-20 under 35 U.S.C. § 102(e) as being clearly anticipated by Johnson et al (USPN 6,625,135). Further, the Examiner rejected Claims 11-12 and 21-23 under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Malki et al. (US 2001/0046223).

No claims have been allowed. The claims have been reproduced above.

3. AMENDMENTS

Claim 16 has been amended to include the limitation of (previously) dependent Claim 17. Since the limitation of (previously) dependent Claim 17 has been incorporated into Claim 16, no new matter has been added by the amendment. Further, Claim 17 has been canceled.

4. SUMMARY OF INVENTION

A novel method for providing IP mobility for mobile networks and detachable mobile network nodes is proposed by Applicants. A demonstration of this method is exemplified by FIG. 1 and at text starting at page 6, line 2. Applicants' Specification, page 6, line 2. The novel method requires that the mobile node maintain "a binding list of one or more correspondent

nodes that the mobile node has been communicating with" when the mobile node is in "a home network" of the mobile node.

5. ISSUE

Whether Claims 16, 19, and 20 are patentable under 35 U.S.C. § 102(e) over Johnson?

6. GROUPING OF CLAIMS

Applicant designates the following group of claims:

Group I: Claims 16, 19, and 20.

7. ARGUMENT

(i) Rejection under 35 U.S.C. § 112, first paragraph: None.

(ii) Rejection under 35 U.S.C. § 112, second paragraph: None.

(iii) Rejection under 35 U.S.C. § 102

Claims 1-2, 4-10 and 14-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Johnson et al. (US 6,625,135). After a careful review of Johnson and the claims, it is believed that the rejection is in error and the rejection is, therefore, traversed.

Applicants believe that the rejection from the Office Action dated January 12, 2004 and the final rejection dated June 24, 2004 are in error. In both office actions, the Examiner asserts that "regarding claims 16-20, in Johnson the binding updates are sent to a home agent (col. 16, lines 41-45)." January 12, 2004 Office Action, pg. 3. June 24, 2004 Office Action, pg. 3. It is noted that the Examiner's reliance upon Johnson appears to be misplaced.

MPEP § 2131 provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F. 2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim

Contrary to the Examiner's statement that all elements are disclosed in the Johnson reference, the limitation that the mobile node maintain "a binding list of one or more correspondent nodes that the mobile node has been communicating with" when the mobile node is in "a home network" of the mobile node is not disclosed in the Johnson reference, so the rejection is unsupported by the art and should be withdrawn.

The Examiner has cited col. 16, lines 41-45 of the Johnson reference in rejecting (previously) dependent Claim 17 which is the claim at issue since the limitation from (previously) dependent Claim 17 has been incorporated into the newly amended Claim 16. Described in this passage is how a home agent router sends binding updates to the excavator (i.e. mobile node 80) when the excavator is at a work site as in FIG. 12. As is known to one of ordinary skill in the art, normally the home agent does not send binding updates. See, for example, the Mobile IP v 6 standard. However, such a disclosure as described in col. 16, lines 41-45 and as known in the art, is irrelevant to the claimed invention that requires the limitation that the mobile node maintain "a binding list of one or more correspondent nodes that the mobile node has been communicating with" when the mobile node is in "a home network" of the mobile node.

For the Examiner to be correct in his assertion that Johnson discloses the elements of the present invention, the limitation that the mobile node maintain "a binding list of one or more correspondent nodes that the mobile node has been communicating with" when the mobile node is in "a home network" of the mobile node needs to be disclosed. Since the cited passage does not disclose the claimed limitation, the Examiner's reliance on Johnson appears to be mistaken.

Thus, the rejection of Claims 16, 19, and 20 under 35 U.S.C. § 102(e) is improper and should be withdrawn.

(iv) Rejection under 35 U.S.C. § 103

Claims 11-12 and 21-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson et al (US 6,625,135) in view of Malki et al. (US 2001/0046223).

To expedite prosecution of the allowable claims, these claims have been canceled.

8. CONCLUSION

For the above reason, Applicants respectfully submit that the rejection of Claims 16, 19, and 20 under 35 U.S.C. § 102(e) is in error and the claims be allowed. Further, to expedite prosecution, Claims 1-2, 4-15, 17-18, and 21-23 have been canceled. Accordingly, this application is believed to be in proper form for allowance and an early notice of allowance is respectfully requested.

Please charge any fees associated herewith, including extension of time fees, to Deposit Account No. 502117.

Respectfully submitted,

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